

REMARKS/ARGUMENTS

The Office Action dated September 9, 2004, has been received and carefully considered. In this response, claims 9, 11, 15, 24, 41 and 43 have been amended. Entry of the amendments to claims 9, 11, 15, 24, 41 and 43, is respectfully requested. Reconsideration of the outstanding rejections in the present application is also respectfully requested based on the following remarks.

I. THE PATENTABILITY REJECTION OF CLAIMS 9-32 AND 41-50

On page 2 of the Office Action, Claims 9-32 and 41-50 stand rejected under 35 U.S.C. § 101 because the claimed invention is alleged to be directed to non-statutory subject matter. Specifically, the Office Action states that “the method of proposing a image-based document handling system does not specifically use technology to carry out ay of the non-trivial claimed method steps.” Accordingly, Applicants have amended independent claims 9, 11, 15, 41 and 43 to further recite that the systems and methods comprise or are performed using a computer operable medium. Applicants respectfully submit that independent claim 24 does not need to be amended because it relates to a “memory for a *computer*.”

Claims 10, 12-14, 16-23, 25-32, 42, 44-50 depend from either claim 9, 11, 15, 24, 41 or 43, and thus relate to the computer operable medium. In view of the foregoing, it is respectfully requested that the aforementioned patentability rejection of claims 9-32 and 41-50 be withdrawn.

II. THE OBVIOUSNESS REJECTION OF CLAIMS 9-32 AND 41-50

On page 3 of the Office Action, claims 9-32 and 41-50 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,249,769 issued to Ruffin et al. (“Ruffin”),

in view of U.S. Patent No. 6,560,639 issued to Dan et al. ("Dan"). This rejection is hereby respectfully traversed.

As stated in MPEP § 2143, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Also, as stated in MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Further, as stated in MPEP § 2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). That is, "[a]ll words in a claim must be considered in

judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970).

Although Applicants disagree with the pending rejections, Applicants have amended the independent claims to further distinguish the claims from the cited references. For example, independent claim 9, a method claim, has been amended to recite “an implementation component that in response to the entity providing information about the infrastructure, the current handling and delivery system and the methodology used by the entity, provides the entity with a plurality of process maps that provide a plurality of step-by-step instructions for executing the image-based document handling and delivery system.” Claim 9 has also been amended to specify that “the plurality of maps compris[e]: at least one process map comprising a process map of the entity’s existing document handling and delivery system, and at least one process map for at least a portion of the image-based document handling and delivery system, and information on a plurality of document formats for use with the image-based document handling and delivery system, wherein the information on the plurality of document formats comprises: a definition of each of the document types; one or more examples of information covered by each of the document types; and a proposed file name for an imaged version of each of the document types.”¹ Claims 11, 15, 24, 41 and 43 have been amended in similar fashion.

¹ Applicants submit that these recitations were previously in the pending claims, but have been revised so as to facilitate an appreciation of claim scope and meaning. In particular, it should be clear to the Examiner that the claimed “plurality of maps” have a well-defined scope that must be considered in assessing the patentability of the claims. Applicants respectfully request that the Examiner review the specific words used in the independent claims and that he reconsider the teachings (and relevance) of the cited references in light of the new claim format.

Applicants respectfully submit that neither Ruffin or Lebda -- alone or in combination -- teach or suggest providing an entity with a plurality of maps in response to the entity completing a questionnaire or providing requested information, for example, wherein such plurality of maps comprise: (1) at least one process map comprising a process map of the entity's existing document handling and delivery system, (2) at least one process map for at least a portion of the image-based document handling and delivery system, and (3) information on a plurality of document formats for use with the image-based document handling and delivery system, wherein the information on the plurality of document formats comprises: (a) a definition of each of the document types, (b) one or more examples of information covered by each of the document types, and (3) a proposed file name for an imaged version of each of the document types.

Moreover, regarding the Office Action's assertion that Ruffin discloses "a proposed file name for each of the document types ... [because] file names are inherent within a data storage device that stores and retrieves data as such system could not function without the ability to call files by names," Applicants respectfully submit the alleged inherency theory is flawed. As stated in MPEP § 2112, "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

Applicants respectfully submit that a teaching of “a proposed file name for an imaged version of each of the document types” does not necessarily flow from Ruffin’s teaching of a mere storage device. The claimed recitation specifically relates to a *proposed* file name for image version of documents to be used with a image-based document handling and delivery system. Applicants submit that in no way does such a teaching necessarily flow from Ruffin’s teaching of “a storage device such as a direct access storage device for storing and retrieving information required for the processing of commands and data.” Accordingly, Applicants respectfully request that the alleged inherency theory be withdrawn.

Claims 10, 12-14, 16-23, 25-32, 42, 44-50 depend from either claim 9, 11, 15, 24, 41 or 43. Thus, since independent claim 9, 11, 15, 24, 41 and 43 should be allowable as discussed above, claims 10, 12-14, 16-23, 25-32, 42, 44-50 should also be allowable at least by virtue of their dependency on independent claim 9, 11, 15, 24, 41 or 43. Moreover, these claims recite additional features which are not claimed, disclosed, or even suggested by the cited references taken either alone or in combination.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 9-32 and 41-50 be withdrawn.

III. CONCLUSION

Since the cited references, taken either singly or in combination, fail to teach or suggest the combinations set forth in the pending claims, and further fail to provide any motivation or suggestion of the desirability of modifying the structures or methods to arrive at the claimed combinations, Applicants submit that the pending claims are allowable over the cited references.

Accordingly, Applicants respectfully request that the Examiner withdraw his rejections, allow the pending claims and pass the application to issue.

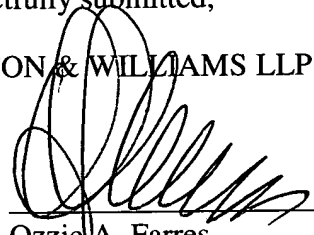
If the Examiner believes that a telephone conference or interview would advance prosecution of this application in any manner, the undersigned stands ready to conduct such a conference at the convenience of the Examiner.

If there are any fees due under 37 C.F.R. §1.116 or §1.117 which are not enclosed herewith, including any fees required for extension of time under 37 C.F.R. §1.136, please charge such fees to our Deposit Account No. 50-0206.

Respectfully submitted,

HUNTON & WILLIAMS LLP

By:


Ozzie A. Farres
Registration No. 43,606

Dated: December 9, 2004
Hunton & Williams LLP
Intellectual Property Department
1900 K Street, N.W.
Suite 1200
Washington, DC 20006-1109
(202) 955-1500 (telephone)
(202) 778-2201 (facsimile)